

Via Facsimile: 703-872-9306  
Attorney Docket No. 283-325

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JUN 10 2005

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Barbara A. Sulzman

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application No.: 09/858,163 Confirmation No.: 3286  
Applicant: Michael Ehrhart  
Filed: May 15, 2001  
Art Unit: 2876  
Examiner: Kimberly D. Nguyen  
Docket No.: 283-325  
Customer No.: 20874

Mail Stop: Art Unit 2876  
Attention: Examiner Kimberly D. Nguyen  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

**CORRESPONDENCE TO RECORD  
SUBSTANCE OF TELEPHONE INTERVIEW**

Sir:

A telephone interview was conducted May 31, 2005 between Examiner Nguyen and the Applicant's representative, George Blasiak.

Applicant's representative began the interview by providing a legal framework for the arguments to be presented. Applicant's representative read the provision of MPEP §2143 that for a *prima facie* case of obviousness to be established the Examiner must show that a reference or references when combined teach or suggest *all* the claim limitations. The Applicant's representative also read the provision that "all words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson* 424

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F.2d 1382 (CCPA 1970), cited in MPEP §2143.03. The Applicant's representative stated that the arguments presented, for purposes of brevity, would be limited to the independent claims and to points necessary to establish that the standing rejections were improperly made but that applicants had preserved the right to make additional arguments in the future.

Regarding claim 1, the Applicant's representative argued in the Office Action of the Examiner at least failed to point out where U. S. Patent No. 5,668,803 to Tymes ("Tymes") contains teachings pertinent to the element of claim 11 of "(b) transmit back to said portable device said decoded-out message." Applicant's representative pointed out that in the Office Action the Examiner merely alleged that Tymes taught a "response" being sent to a portable device, but that the Examiner failed to allege that Tymes taught elements related to sending back to a portable device a "decoded-out message" generated by decoding a representation of a bar code symbol.

In response to the above argument the Examiner stated that the Examiner had "stretched" the teachings of Tymes to satisfy applicants specifically recited claim limitations. The Examiner acknowledged that the Tymes did not teach sending a decoded-out message generated by decoding a bar code symbol to a portable device, and admitted that Tymes only teaches sending a "response" to portable device. The Examiner indicated that during searching the Examiner could not find the sending a decoded-out message feature in the prior art, and therefore, liberally construed the claim and/or the reference in order to complete the rejection of claim 11.

Regarding claim 17, the Applicant's representative pointed out that the May 6, 2005 Office Action at least failed to allege that the prior art relied upon by the Examiner had teachings relating to "writing said decoded-out message data...into said image file open byte memory location." In response to the above argument the Examiner stated that the Examiner did not give the claim elements relating to an image file having an open byte memory location "much weight" and at the end of the interview the Examiner stated that the Examiner

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could not find the limitation of "writing said decoded-out message data...into said image file open byte memory location" in the prior art.

Regarding claim 22, the Applicant's representative pointed out that the May 6, 2005 Office Action at least failed to allege that the prior art relied upon by the Examiner had teachings relating the specifically recited claim limitation of "(c) converting said decoded-out message data into an image representation of said decoded-out message data." Applicant's representative asked the Examiner to point out the teachings of Tymes relating to "(c) converting said decoded-out message data into an image representation of said decoded-out message data." In response, the Examiner did not attempt to point out any prior art teaching relating to "(c) converting said decoded-out message data into an image representation of said decoded-out message data" and requested that the applicant's representative make a record of the argument presented by the applicant's representative as to claim 22.

Regarding claim 30, the Applicant's representative pointed out that the May 6, 2005 Office Action at least failed to allege that the prior art relied upon by the Examiner had teachings relating to "(a) actuating an image capture function of said device...to capture a first image representation corresponding to a first view of a package." The Examiner did not attempt to clarify the rejection of claim 30; but rather requested that the applicant's representative make a record of the argument presented as to claim 30.

During the interview the Applicant's representative indicated that an Examiner is precluded from grouping several claims into an omnibus rejection unless that rejection "is equally applicable to all claims in the group" MPEP §707.07(d). The Applicant's representative asserted that it appeared the Examiner had grouped claims 11, 17, 22, and 30 even though the omnibus rejection was not equally applicable as to all of the claims.

The Examiner, after reviewing the claims during the interview and, apparently acknowledging that an additional Office Action would have to be rendered if the claim rejections were to be maintained, indicated that a restriction requirement might be applied as

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to the pending claims. The Applicant's representative pointed out that the subject matter of claims, though different, was related and that a restriction requirement at the present stage of prosecution would be untimely. A restriction requirement is timely only if it is given as early as possible in the prosecution and before any action on the merits if the distinction between the inventions is clear. MPEP §811. Because action on the merits has already been rendered as to claims 11, 17, 27, and 30 without the Examiner alleging that claims 11, 17, 27, and 30 are unclear, a restriction requirement respecting claims 11, 17, 27, and 30 at the present time would be untimely under the provision of MPEP §811. Further, in reviewing the application file subsequent to the interview, Applicant's representative notes that several claims of the application have already been restricted in a restriction requirement dated September 1, 2004. Accordingly, it appears that a restriction requirement as to claims 11, 17, 27 and 30 could have been presented earlier in the prosecution, i.e., at the time the Examiner deemed it to be proper to present restriction requirements as between the groups designated in the September 1, 2004 restriction requirement. Still further, with the common grouping of claims 11, 17, 27 and 30 in the restriction requirement of September 1, 2004 the Examiner has admitted that claims 11, 17, 27 and 30 do not require restriction. Also, claims 11, 17, 22, and 30 have all been indicated to have been fully searched by the Examiner, and the Examiner has presented two separate reasons for rejection as to each of claims 11, 17, 22, and 30, both of which have been demonstrated to be improper by the applicant. As indicated in applicants' response of February 2, 2005, it is believed that with the restriction requirement of September 1, 2004, the Patent Office operated under MPEP §819.01 (permissive shift).

In summary, during a telephone interview on May 31, 2005, the applicant's representative pointed out significant deficiencies in the rejections presented by the Examiner for each respective independent claim. In response to the arguments presented, the Examiner did not attempt to substantively defend any outstanding rejection (except to the extent that the Examiner explained certain rejections were based upon what the Examiner termed a "stretched" construction of the prior art teaching and/or claims), and the Examiner did not attempt to explain any standing rejection with reference to any specific teachings of the prior art.

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Accordingly, in view of the above remarks, applicants believe all of the claims of the present application to be in condition for allowance and respectfully request reconsideration and passage to allowance of the application.

If the Examiner believes that contact with applicants' attorney would be advantageous toward the disposition of this case, the Examiner is herein requested to call applicants' representative at the phone number listed below.

The Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to deposit Account No. 50-0289.

Respectfully submitted,  
WALL MARJAMA & BILINSKI LLP

Date: June 10, 2005

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